

Mail Stop INTERFERENCES
P.O. Box 1450
Alexandria, Virginia 22313-1450
Tel: 571-272-9797
Fax: 571-273-0042

Paper **B**

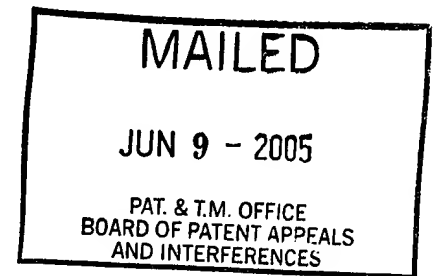
UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,297
(From Technology Center 1600)

SHIN-ETSU CHEMICAL CO. LTD.
(6,280,898 B1),
Junior Party,

v.

NEC CORPORATION
(09/750,116),
Senior Party.



REDECLARATION - Bd.R. 203(c)

Before TORCZON, Administrative Patent Judge.

A. Redeclaration of interference

The interference is redeclared (Bd.R. 203(c)) to substitute the count and to accord additional benefit.

New count 2

A new count 2 is substituted for count 1 pursuant to the conference call summarized in Paper 22. Shin-Etsu has filed (Paper 27) a list of points of disagreement with count 2. While Shin-Etsu's proposed count 3 will not be adopted, Shin-Etsu may file a motion seeking the relief described in Paper 27.¹

¹ Shin-Etsu's desired relief appears to be the exclusion of polymers with a specific comonomer that NEC allegedly does not support. Since count 2 is entirely silent on the subject of comonomers and NEC reportedly did not invent a use including the comonomer, the putative problem does not appear to be in count. 2, but rather in the designation of Shin-Etsu claims requiring the comonomer as corresponding to the count. If so, Shin-Etsu may file a motion to undesignate such claims in lieu of the motion to substitute count 3.

Additional accorded benefit

Certified translations of foreign benefit applications having been supplied, Stevens v. Tamai, 366 F.3d 1325, 1332, 70 USPQ2d 1765, 1770 (Fed. Cir. 2004), the accorded benefit has been reconsidered and the foreign benefit has been accorded as provided below. The consequence of this reconsideration is that the order of the parties is inverted. Bd.R. 207(a). Each party is authorized to file a motion attacking the accorded benefit of its opponent.

- B. [No change]
- C. [No change]
- D. [Omitted]
- E. The parties to this interference

Junior Party

Inventors: Koji HASEGAWA, Tsunehiro NISHI, Takeshi KINSHO, Jun HATAKEYAMA, and Osamu WATANABE, all of Nakakubiki-gun, JAPAN

Patent: 6,280,898 B1 [898], issued 28 August 2001
(09/404,763, filed 24 September 1999)

Title: Novel lactone-containing compounds, polymers, resist compositions, and patterning method

§102(g) benefit: JP 10-270373, filed 25 September 1998

Senior Party

Inventors: Katsumi MAEDA, Shigeyuki IWASA, Kaichiro NAKANO, and Etsuo HASEGAWA, all of Tokyo, JAPAN

Application: 09/750,116 [116], filed 29 December 2000

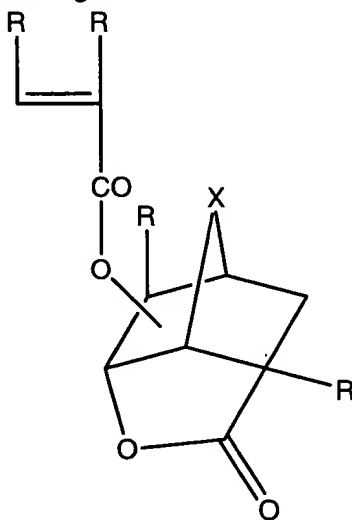
Title: (Meth) acrylate derivative, polymer and photoresist composition having lactone structure, and method for forming pattern by using it

§102(g) benefit: PCT/JP99/03580, filed 2 July 1999
JP 10-188853, filed 3 July 1998

F. Count and claims of the parties

Count 2

The compound of the following formula:



where each R is independently hydrogen or methyl, and
X is CH₂ or CH₂CH₂.

The claims of the parties are:

Shin-Etsu: 1-23

NEC: 1-21

The claims corresponding to Count 2:

Shin-Etsu: 1-20
NEC: 1-5, 8-19 & 21-23

The claims not corresponding to Count 2:

Shin-Etsu: 21
NEC: 6, 7 & 20

G. Heading to be used on papers; exhibit numbers

Addendum 1 provides the heading that shall be used on all further papers filed in the contested case. See SO ¶ 7.2.1.

Despite the change in the order of the parties, the range of exhibit numbers is NOT changed and remains assigned as follows (Bd.R. 154(c)(1); SO ¶ 20.2.1):

Shin-Etsu: 1001-1999.

NEC: 2001-2999.

H. [Omitted]

I. [No change]

Interference No. 105,297
Shin-Etsu Chemical Co. Ltd. v. NEC Corporation

Paper 31
Page 5

cc (via first-class mail):

For NEC Corporation:

George E. Quillin (202-672-5413)
John J. Feldhaus (202-672-5403)
Sean A. Passino (202-295-4166)
FOLEY & LARDNER LLP
3000 K ST STE 500
WASHINGTON DC 20007-5109
Fax: 202-672-5399

For Shin-Etsu Chemical Co. Ltd.:

Anthony J. Zelano (703-812-5311)
John A. Sopp (703-812-5315)
Brion P. Heaney (703-812-5308)
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD STE 1400
ARLINGTON VA 22201
Tel: 703-243-6333
Fax: 703-243-6410

Interference No. 105,297
Shin-Etsu Chemical Co. Ltd. v. NEC Corporation

Paper 31
Page 6

ADDENDUM 1

Filed on behalf of: [Name of Party]
By: [Name of lead counsel
Name of backup counsel
Street address
City, State, and ZIP Code
Tel:
Fax:]

Paper No. [Leave blank]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Torczon)

SHIN-ETSU CHEMICAL Co. LTD.
(6,280,898 B1),
Junior Party,

v.

NEC CORPORATION
(09/750,116),
Senior Party.

Patent Interference No. 105,297

TITLE OF PAPER